

UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of Bjarke de Jager Gotfredsen
Application No.: 09/674,714
Filed: December 19, 2000
For: Mouse Pad Comprising a Card Read/Write
Device

Date: September 1, 2004
Group Art Unit: 2876
Examiner: Jamara Franklin
Attorney Ref. No.: 105.01

Appellate Brief

Board of Patent Appeals and Interferences
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

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Dear Sir or Madam:

The applicant respectfully submits this appeal brief.

Real Party in Interest

The real party in interest is the assignee of this patent application, Scard Technologies.

Related Appeals and Interferences

None.

Status of Claims

Claims 1 -32 are currently pending, and stand rejected under 35 U.S.C. § 103. The applicant appeals the rejection of all pending claims.

Status of Amendments

The applicant filed after-final amendments to place the application in better condition for consideration on appeal. (See 12/16/03 Amendments). These amendments reversed earlier amendments that attempted to offer a definition of "mouse pad."

The examiner refused to allow the after-final amendments, and the applicant filed a petition for entry of these amendments on July 16, 2004. That petition is currently pending.

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However, the claims are allowable, with or without the amendments, since the cited prior art simply does not show a "mouse pad," as required by each claim of the presentation application.

Summary of Invention

The present invention is a mouse pad formed with a data storage or data input device. In one embodiment, the data storage or data input device is a smart card read/write device. By combining the data storage or data input device into the mouse pad, scarce desk space can be conserved.

The present invention was developed in 1997, and claims priority from a Danish application filed in May, 1998. *See Filing Receipt; Rule 1.131 Decl. of Bjarke de Jager Gotfredsen.* The applicant has obtained corresponding patents in Australia (14834/99) and Europe (EP 1 076 879 B1).

Issues

Does the Patent reference disclose a "mouse pad" within the meaning of the claims of the present invention?

Did the examiner properly reject some of the claims under § 112 based on the assertion that "relatively small" was indefinite?

Did the examiner err by failing to consider claims 15, 18, and 20?

Grouping of Claims

All the claims will stand or fall together for purposes of the arguments raised on appeal, except that no art-based rejection has been expressly made against claims 15, 18, and 20.

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Argument

I. Overview

The present invention contains a combination that is simply not taught or suggested by the prior art: a data storage or input device formed by a mouse pad.

The examiner has not found any reference that shows such a device, nor any reference that suggests such a device. Instead, the examiner has stretched the definition of "mouse pad" beyond recognition, by ruling that "any flat surface on which a mouse may operate may constitute a 'mouse pad.'" (11/5/03 Office Action at 4). Using this overly-broad definition, the examiner found that the a desk pad described in an untranslated French language PCT application (Patret) is a "mouse pad," even though the reference itself never so states or suggests.

By adopting an unreasonably broad definition of "mouse pad," the examiner has violated the cardinal rule that claim terms are given their ordinary meaning, unless the applicant has defined them in a special way. See MPEP § 2111.01 ("the words of the claim must be given their plain meaning unless applicant has provided a clear definition in the specification"). No one would say that a wall, or a book, or a cracker is a "mouse pad," but under the examiner's overbroad definition all these objects would qualify as mouse pads because they have flats surfaces that can support a mouse. The examiner's rejections should be reversed and all claims allowed.

II. Background

The examiner in this case issued a number of art-based rejections, based on a shifting assortment of prior art references. First, the examiner issued a rejection based primarily on the Lester (US Patent No. 6,061,446) and Braun (US Patent No. 6,300,936) references. (See 6/20/02 Office Action.) The applicant responded by antedating these references. (See 10/17/02 Office Action Response.)

The examiner then responded by issuing a rejection based on different prior art, namely the Wilson design patent (D 380,462), the Okaya patent (U.S. Patent No.: 5,625534), and

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the Panasik patent (U.S. Patent No.: 5,987,547). (See 1/16/03 Office Action.) None of these references showed or suggested a mouse pad combined with read/write device.

The applicant then attempted to conduct an interview with the examiner, but this effort was delayed because the examiner lost the file, so the applicant sent her the claims. An interview was then conducted on April 22, 2003, and the applicant argued that the cited references were materially different than the present invention. (See 5/27/03 Recordation of Substance of Interview.) After the interview, the examiner conferred with her supervisor, and the examiner indicated that the arguments were persuasive, and that the art-based rejections would be withdrawn if the arguments were made in a formal office action response. (Id.) The applicant then filed his second office response, incorporating the arguments made during the interview. (See 5/27/03 Office Action Response.)

In response, the examiner did abandon the previous art-based rejection, but issued a new rejection, based primarily on a previously-uncited reference, namely the Patret PCT Application (PCT WO 95/24008). (See 11/5/03 Office Action.)

As explained below, Patret relates to desk pads, not mouse pads, and the applicant underscored that point in an interview on November 20, 2003. (See 12/17/03 Office Action Response at 4.) During the interview, the applicant proposed adding a conventional definition of "mouse pad" to the claims, and the examiner indicated that such an amendment would result in allowance. (Id.) Thus, the applicant conditionally amended all the claims to include the proviso "wherein said mouse pad comprises a relatively small pad with a substantially planar running surface." (See 12/17/03 Office Action Response at 11.) Because previous experience caused the applicant to be wary of the examiner's assurances, the applicant expressly made the amendments conditional: "The applicant *conditionally* amends the claims as follows below. These amendments should only be entered if they are both sufficient and necessary for allowance of the claims." (See 12/17/03 Office Action Response at 4 (emphasis in original.))

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In response, the examiner entered the amendments, found that the amendments created a new § 112 rejection, and issued a final obviousness rejection based on the Patret "desk pad" reference. (See 4/6/04 Office Action.) The applicant then filed an amendment to put the application in better condition for appeal, by removing the amendments that created the § 112 rejection. (See 5/28/04 After Final Amendments.) The examiner refused to enter the amendments, even though it is obvious that the amendments put the application in better condition for appeal by removing the new language that prompted the § 112 rejection. (See 6/9/04 Advisory Action.)

The applicant then petitioned for entry of the amendments, and filed a notice of appeal. (See 6/28/04 Notice of Appeal; 7/16/04 Petition for Entry of Amendment.) No ruling has yet been made on the petition.

The present appeal focuses on the merits of patentability, that is, whether Patret's "desk pad" is a "mouse pad." However, the applicant wishes to protest his mistreatment by the examiner. The applicant, who is a Danish national, has received vastly different treatment from the USPTO than from other patent offices. His application was efficiently examined and approved in Europe (EP 1 076 879 B1) and Australia (14834/99).

But here, the applicant was subjected to: (i) piecemeal examination in violation of MPEP 707.07(g), as the examiner rotated through three different sets of references before settling on Patret, even though the present application has been granted special status because of actual infringement, (ii) unreliable assurances that the patent would be granted if only certain changes were made to the application, (iii) a lost file, (iv) an unexplained failure to examine certain claims (see below), and (v) failure to enter amendments that clearly place the claims in better condition for consideration on appeal by removing a § 112 rejection.

The applicant looks forward to consideration of the merits of this matter on appeal, and hopes that if the matter is remanded any remaining proceedings are conducted with

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efficiency and fairness.

III. The Examiner's Definition of "Mouse Pad" Is Unreasonable

The examiner's § 103 rejection depends on her definition of "mouse pad": "any flat surface on which a mouse may operate." (11/5/03 Office Action at 4.) Based on this definition, the examiner found that Patret's "desk pad" is a mouse pad, and therefore found the present invention to be obvious in light of Patret. (4/6/04 Office Action.) However, the examiner's "any flat surface" definition is overly broad, and should be rejected.

Examiners should give claim terms "their broadest reasonable interpretation consistent with the specification," but it is not reasonable to define mouse pad as "any flat surface on which a mouse may operate." (MPEP § 2111; 11/5/03 Office Action at 4.)

This definition is unreasonable because it is overbroad. Under this definition, the following objects would qualify as mouse pads because they have flat surfaces that could support a mouse:

1. computer housing;
2. the flat top of an external disk drive;
3. a desktop;
4. a crisp cracker, such as a Ry-Crisp;
5. a hardcover book, laid on its side;
6. a countertop;
7. an ironing board;
8. a piece of cardboard;
9. a flat rock; and
10. the user's smooth-soled shoe, when turned upside down.

Of course, it is ridiculous to call any of these objects "a mouse pad," but the examiner's definition would so classify each. The examiner's proposed definition of "mouse pad" is unreasonable because it includes a number of objects that are clearly not mouse pads.

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See *In re Cortright*, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999) (rejecting unreasonable interpretation of claim). While every mouse pad has a flat surface, not every flat surface is a mouse pad.

The specification gives no indication that the applicant adopted a special meaning of "mouse pad." Instead, the application described the present invention as "like a *conventional* mouse pad," except that it has a read/write device embedded in it. (Published Application at page 5 (emphasis added.))

Therefore, there is simply no support for the examiner's overly-broad definition of "mouse pad," and it should be rejected.

With that definition rejected, there is no basis for construing Patret's "desk pad," as a mouse pad. Patret does not describe its desk pad as a mouse pad, nor would one skilled in the art equate a desk pad with a mouse pad. Instead, a person skilled in the art would understand that a mouse pad is a *small* pad, with ample but not extraneous space for mouse movement. Thus, some dictionaries use a specific area in defining mouse pad, such as the following definition:

mouse pad
A fabric-covered pad roughly 9" square that provides a smooth surface for rolling a mouse.

Computer Desktop Encyclopedia, Alan Freedman, (The Computer Language Company, 1996)
Appendix B.

Similarly, an online dictionary offers this definition:

mouse mat
<hardware> (U.S.: "mouse pad") A small sheet with a special surface for a rolling ball mouse to move on. Most mouse mats are sheets of rubber or foam about 20 cm by 25 cm and about 5 mm thick with one side covered with cloth or sometimes hard plastic. Deluxe versions come combined with a wrist rest.

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It is rare to find a mouse mat which does not carry some form of advertisement for some company or other. They are such a common free gift that few people actually have to buy one.

Mats are supposed to provide better traction and a clean, lint-free surface over which to move but it debatable whether they are useful at all, or whether any appropriate surface (preferably hard, even, flat, and clean) is as good. However, some mice which use optical (e.g. Sun) or radio-frequency sensors (e.g.?) to detect motion (instead of using a rolling ball) will only work on specially designed mouse mats. Critics may consider this to be part of the connector conspiracy, though the designers would claim greater reliability due to the absence of moving parts.

FOLDOC (Free Online Dictionary of Computing, wombat.doc.ic.ac.uk/foldoc/, accessed 8/29/04), Appendix B.¹

Patret's pad certainly does not fit either of these definitions. Its flat surface is described as a "work surface" or "desk pad," and it is big enough to write on, unlike a mouse pad. (Patret 1: 55 - 65). While a mouse can roll on a desk pad, that facts does not transform every desk pad (including Patret's) into a mouse pad. As one lexicographer noted:

A **mousepad** is a little pad on which you can roll your mouse around. There is nothing special about a mousepad — your mouse will work just fine on the plain ol' desk or on a piece of a cardboard (unless you have an *optical mouse* which needs a mousepad with a reflecting grid built into, but you would know if you did). The advantage of the mousepad is that the surface is usually designed to give a better grip on the mouse ball than you can get on your desk.

Jargon, an informal dictionary of computer terms, Robin Williams (Peachpit Press,

¹ The claims of the present patent application are not limited to mouse pads of any particular area, but the claims do exclude pads that are so large that it is clear that their primary purpose is not to provide a running surface for a mouse.

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1993). Thus, while many flat surfaces (a desk, a piece of cardboard) can function as a mouse pad, a mouse pad is one type of flat surface, designed specifically for mouse movement. Put another way, if all flat surfaces *were* mouse pads, as the examiner has asserted, then the dictionary definition above would so state, and would not draw a contrast between mouse pads and other flat surfaces. It also would be just plain weird to call every flat surface a mouse pad, since it would make mouse pads ubiquitous.

Thus, there is no escaping the conclusion: only by using an unreasonably broad definition could Patret's desk pad be defined as mouse pad. And without a mouse pad, Patret cannot anticipate or render obvious the present claims, all of which require a mouse pad.

IV. The § 112 Rejection Should Be Withdrawn

The examiner has rejected all the claims because they contain the term "relatively small." (4/6/04 Office Action at 2.)

However, relative terms are allowed, especially where, as here, the specification contains guidance on how to interpret those terms. *Seattle Box Co., Inc. v. Industrial Crating and Packing, Inc.*, 221 USPQ 568, 573- 74 (Fed. Cir. 1984) ("[w]hen a word of degree is used the district court must determine whether the patent's specification provides some standard for measuring that degree").

In this case, the specification *does* provide exemplary dimensions for a "conventional mouse pad": "245 x 205 mm." (Specification at 5.) This specific dimension clearly provides "some standard" for measuring the claim term "relatively small."

If the Board nonetheless finds the phrase to be indefinite, then the applicant stands willing to amend his claims to exclude the offending phrase "relatively small." Indeed, the applicant has already attempted to do so, and the examiner's refusal to enter this amendment is the subject of a co-pending petition. The applicant only added the term

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"relatively small" when the examiner suggested that the patent would be allowed if a definition of mouse pad were imported into the claims. The applicant believes that "mouse pad" is a well-known term that needs no definition.

V. The Examiner Has Not Addressed Claims 15, 18, and 20

In her November 5, 2003 Office Action, the examiner made no mention of claims 15, 18, and 20. The Applicant responded by noting the oversight. (See 12/17/03 Office Action Response at 3.)

But in her next Office Action, the examiner still made no mention of these claims, except by including them in the § 112 rejection. (See 4/6/04 Office Action.) Presumably, the examiner has some art-based rejection for claims 15, 18, and 20, since otherwise she would have allowed them in her November 5, 2003 Office Action. But she has failed to articulate this rejection, even after being reminding of her duty to do so. MPEP 707.07(i) ("Each Claim to be Mentioned in Each Office Action").

Since the examiner has not articulated an art-based rejection for claims 15, 18, and 20, these claims should be allowed if the § 112 rejection is overcome.

Conclusion

The examiner's rejection depends on an unreasonably broad definition of "mouse pad," and thus the rejections should be reversed and all claims allowed.

Dated: September 1, 2004

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